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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,412	02/05/2002	Jean Charles Le Huec	02581-P0438A	7883

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EXAMINER
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MAIORINO, ROZ

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/067,412

Applicant(s)

LE HUEC ET AL.

Examiner

Roz Maiorino

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-11 is/are rejected.
- 7) ☒ Claim(s) 9-11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 9-11 objected to because of the following informalities:
  - a. in claim 9, the applicant stated "in accordance with claim 1" line 2; its not clear if claim 9 is an apparatus claim, a method claim, if claim 9 is an independent claim or a dependent claim. Applicant must either remove the method terminology from claim 9 or add all the limitation states in claim 1.
  - b. In claims 10-11 applicant states "blades following procedure b)" line 4. applicant must write out procedure b), its not clear if in claim 9 procedure b) is followed by procedures c) and d) or if its only limited to the steps in procedure b). to eliminate any confusion applicant must write out all of the steps in every claim instead of referring to them as procedure b). Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 3-11 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5064428 to Cope et al.

Cope teaches a hollow cylindrical encasing trocar tube (127) which can be inserted in to an artificial body opening and an expander (100) which can be extracted from and retracted into the trocar tube, expander is characterized in that the expander has a retraining element arranged outside trocar tube in addition to two to four spring blades (101-106) which are made of a flexible material and form an arc in the respective middle section, whereby said blades shifted towards one another on the treating element in such a way that the plane surface created by the arc are intersecting.

3. Claims 1, 3-5, 7-11 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 589153 to Peterson.

Peterson teaches a hollow cylindrical encasing trocar tube (31) which can be inserted in to an artificial body opening and an expander (33) which can be extracted from and retracted into the trocar tube, expander is characterized in that the expander has a retraining element arranged outside trocar tube in addition to two to four spring blades (11, 9, 10, 19) which are made of a flexible material and form an arc in the respective

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middle section, whereby said blades shifted towards one another on the treating element in such a way that the plane surface created by the arc are intersecting.

4. Claims 1, 3-5, 7-11 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6174318 Bates et al.

Bates teaches a hollow cylindrical encasing trocar tube which can be inserted in to an artificial body opening and an expander which can be extracted from and retracted into the trocar tube, expander is characterized in that the expander has a retraining element arranged outside trocar tube in addition to two to four spring blades which are made of a flexible material and form an arc in the respective middle section, whereby said blades shifted towards one another on the treating element in such a way that the plane surface created by the arc are intersecting.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6174318 to Bates et al or US Patent No. 5891153 to Peterson as applied to claim 1 above, and further in view of US Patent NO. 50064428 to Cope et al.

As mentioned above both Bates and petereson teach the invention except for the blades being made out of TiNi.

Cope teaches the blades being made out of TiNi.

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Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to have made the blades from TiNi, because according to Cope TiNi "exhibits a superelastic property when maintained at a temperature above its transformation temperature. The transformation temperature of the superelastic basket wire is selected to be below the normal operating temperature of the basket to maintain the basket wire in a superelastic state. In such state, the superelastic basket wires advantageously return to their original shape when a deformation stress is removed from the wire. The superelastic alloy wire also increasingly resists deformation as the stress load is increased. When nitinol wire is operated below its transformation temperature, heat must be applied to return the alloy wire to its original shape." (Col. 2 lines 20-40)

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1, 3-11 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roz Maiorino whose telephone number is 703-305-2336. The examiner can normally be reached on 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 703-308-2698. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RM

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